



PATENT
P53821C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

Noted

Appeal No. _____

In re Application of:

Richard G. Hyatt Jr.

Serial No.: 08/720,070

Examiner: Suzanne Lale Dino Barrett

Filed: 27 September 1996

Art Unit: 3673

For: ELECTROMECHANICAL CYLINDER PLUG

REPLY BRIEF

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O.Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §41.41(a), Appellant hereby requests entry of this Reply Brief in response to the Examiner's Answer mailed on 6 October 2010.

A written Request for Oral Hearing before the Board of Patent Appeals and Interferences and the statutory fee incurred by that Request accompany this Reply Brief.

Folio: P53821C

Date: 12/6/10

I.D.: REB/kf

REMARKS

The Examiner's Answer mailed on 6 October 2010 has been carefully considered.

Withdrawal of the provisional double patenting rejection of claims 1-5, 11-13, 34, 65-69, 75, 92-100, 112, 121 in view of Hyatt U.S. Patent No. 6,564,601 is noted with appreciation.

The Examiner's Answer belatedly asserts that the phrase ***broadest reasonable interpretation*** justifies the of the explicit teachings of the prior art of record, and the amorphous interpretation of the subject matter as a whole set forth in the finally rejected claims for which Appellant seeks patent protection.

Claims 25, 26, 30-33, 39-42, 46-52, 54-56, 64, 70, 76, 77, 82-84, 91, 107, 108, 109, 111, 113-116, & 119-121

The Examiner's Answer makes a finding-of-fact that,

"Gokcebay itself teaches motivation for providing all electronics and hardware within the plug (col. 2, lines 53-55; col. 3, lines 2-6; col. 10, lines 12-19), instead of [*sic, in*] the shell as in Thordmark, ... the wholesale substitution of Thordmarks's of Thordmark's locking member and detent for the blocking pin (detent) 38 of Gokcebay would have been been obvious to a person of ordinary skill in the art at the time the invention was made in view of the combined teaching [*sic, teachings*] of Gokcebay, Thordmark and Naveda, since such a

person would have been motivated based on the desirability to miniaturize and place all elements within the plug (barrel) for easily retrofitting plugs (barrels) in electro-mechanical cylinder locks taught by Gokcebay and Naveda and further for enhancing the lock device by providing a secondary locking means for the detent as taught by Thordmark.”

There are errors in the Examiner’s foregoing statement of the findings-of-fact, and the evidence introduced into the administrative record contradicts the foregoing findings.

First, Gokcebay ‘777 itself, and ostensibly the Examiner’s proposed combination, correspond to Appellant’s non-elected Species illustrated by Appellant’s FIG. 8H. The administrative record contains a finding-of-fact about Appellant’s non-elected Species illustrated by Appellant’s FIG. 8H, and a conclusion-of-law made on the administrative record, that the non-elected Species illustrated by Appellant’s FIG. 8H is patentably distinct from Appellant’s elected Species defined by the pending claims.

Moreover, the administrative record is devoid of findings-of-fact which would contradict the conclusion of patentable distinctiveness.

Second, these elected claims explicitly define structures with various definitions of physical cooperation between “a stationary bar borne by said shell and interposed between said shell and said cylinder plug,”¹ while nothing in the Examiner’s proposed combination

suggests Appellant's:

"stationary bar ... and an electrical operator moving independently of said bar between one of a first orientation accommodating relative movement between said shell and said cylinder plug and a second and different orientation maintaining obstruction of said relative movement by engaging said bar"

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Recognizing that all of the constituent parts of the proposed combination move, Appellant suggest that the Board question precisely where is a finding-of-fact set forth in the Examiner's Answer explaining precisely where, in the Examiner's "wholesale substitution of Thordmarks's of Thordmark's locking member and detent for the blocking pin (detent) 38 of Gokcebay would have been been obvious to a person of ordinary," a person of ordinary skill would learn about how "Thordmark's locking member and detent for the blocking pin (detent) 38 of Gokcebay would" achieve engagement of Appellant's ***stationary bar*** by Appellant's "an electrical operator moving independently of said bar?"

Appellant respectfully submits that the structure of claim 25 would impermissibly prevent both the primary and the two secondary references from operating in their respective intended modes of operation.

Appellant further respectfully further submits that this conclusively demonstrates that existence of a *prima facie* showing of the obviousness of claim 25.

Claim 46 contemplates "a bar borne by said plug ... interposed between said shell and said cylinder plug to reciprocate generally along a radial plane ... and an electrical operator ... obstructing movement of said bar ... by moving with a second and different plane not coextensive with said radial plane ...".

All of the constituent elements of the Examiner's proposed combination necessarily move in the same common plane. Precisely where does the Examiner's "wholesale substitution of Thordmarks's of Thordmark's locking member and detent for the blocking pin (detent) 38 of Gokcebay would have been obvious to a person of ordinary," a person of ordinary skill would learn about how "Thordmark's locking member and detent for the blocking pin (detent) 38 of Gokcebay would" achieve Appellant's "a bar borne by said plug ... to reciprocate generally along a radial plane ... and an electrical operator ... moving with a second and different plane not coextensive with said radial plane ...?"

Appellant respectfully submits that the structure of claim 46 would impermissibly prevent both the primary and the two secondary references from operating in their respective intended modes of operation.³

Claim 56 defines such features of a lock as,

"an electrical operator ... moving independently of said travel by

³ As an aside, and despite the Examiner's insistence about the teaching of Gokcebay '777, the Board may take some comfort in the fact the Mr. Gokcebay, as evidenced by his work contemporaneously with, and later, when in a different direction in exploiting the principles of his invention. Gokcebay '777 merely tangentially touched one non-elected species of Appellant's specification.

said elongate member in a second direction within a plane that
 maintains said simultaneous engagement but is not aligned with
 said radial direction . . .”

The Board is respectfully invited to observe that in the Examiner’s proposed combination, the “electrical operator” and all other constituent component necessarily move both in the same plane, and in serial dependence upon one another. Consequently, the administrative record is devoid of evidence that would support a *prima facie* showing of obviousness. Moreover, the modifications required by the Examiner’s proposed combination would impermissibly prevent the primary reference from operating in its intended mode of operation.

 Claim 64 defines,

 “said sidebar having a first portion that is positioned to be
 optionally blocked by another component of said lock
 functioning independently of said electrical operator to prevent
 travel of said sidebar, and a second portion that is positioned to
 be blocked from said travel by said sidebar . . .”

Both the Examiner’s proposed combination, the primary reference, and both of the secondary references lack suggestion of Appellant’s cooperation between the electrical operator and another component with a sidebar. Unclear is whether the Examiner’s proposed combination will require two independently moving sidebars?

 What is clear when reading Appellant’s claims 64, 65, 70, 76, 77, 91, 120 and 121,

is that the insertion of Appellant's bar, or sidebar, between *blocking pin 38* of the primary reference and *cylinder shell 46* of Gokcebay '777 in a misguided effort to replicate Applicant's cooperation between the bar, or sidebar, and the electrical operator, would impermissibly prevent the primary reference from operating in its intended mode of operation whereby,

"a bore or recess 50 into which the blocking pin 38 extends *in the blocking position*,"

and,

"the cylinder plug 24 is rotatable within the cylinder shell 46 *only when* the blocking pin 38 has been retracted by the solenoid 36."

Nothing in the two secondary references contemplated either modification or accommodation of the primary reference's taught mode of operation. Accordingly, the necessary prevention of the intended mode of operation of the primary reference is persuasive evidence of the absence of a *prima facie* showing of obviousness on the evidence in the administrative record.

The Board is respectfully invited to refuse to sustain these rejections. Such action is respectfully urged to these reasons, and for the reasons stated in Appellant's first, and subsequent Appeal Briefs.

Claims 107-109, 111, & 113-116

Dependent claims 107 through 109, 111, and 113 through 116 define one feature of Appellant's lock as,

"said bar [or, sidebar] engaging both said shell and said cylinder plug during said rotation."

In contradistinction, without a hindsight reconstruction of the art in the light provided by Appellant alone, insertion of a bar, or sidebar, between **blocking pin 38** of the primary reference and **cylinder shell 46** would impermissibly prevent the primary reference from operating in its intended mode of operation whereby,

"a bore or recess 50 into which the blocking pin 38 extends **in the blocking position**,"

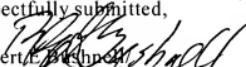
and,

"the cylinder plug 24 is rotatable within the cylinder shell 46 **only when** the blocking pin 38 has been retracted by the solenoid 36."

Nothing in the two secondary references contemplated either modification or accommodation of the primary reference's taught mode of operation. Accordingly, the necessary prevention of the intended mode of operation of the primary reference is persuasive evidence of the absence of a *prima facie* showing of obviousness on the evidence in the administrative record.

A Request for Oral Hearing accompanies this Reply Brief. The Commissioner is respectfully requested to charge Deposit Account No. 02-4943 of Appellant's undersigned attorney in the amount of \$540.00 (Small Entity) incurred by requesting an Oral Hearing. Should the Request become lost, the Commissioner is kindly requested to treat this paragraph as such a request, and is authorized to charge Deposit Account No. 02-4943 of Appellant's undersigned attorney in the amount of such fee.

Respectfully submitted,


/Robert E. Bushnell
Robert E. Bushnell,
Registration No.: 27,774

Customer No. 008439
2029 "K" Street N.W., Suite 600
Washington, D.C. 20006-1004
(202) 408-9040

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